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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,614	12/12/2003	Jean Renard Ward	P0916D	1705
23735	7590	10/09/2007	EXAMINER	
DIGIMARC CORPORATION			TURCHEN, JAMES R	
9405 SW GEMINI DRIVE			ART UNIT	PAPER NUMBER
BEAVERTON, OR 97008			2139	
			MAIL DATE	DELIVERY MODE
			10/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/734,614	WARD, JEAN RENARD	
Examiner	Art Unit		
James Turchen	2139		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 19 July 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-32 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_  
  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application  
6)  Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 1-32 are pending. Claims 1-4, 14, 21, 22, 24, 29, 31 and 32 are amended.

Claims 33-41 are cancelled.

***Response to Arguments***

Applicant's arguments filed 07/19/2007 have been fully considered but they are not persuasive.

Regarding claim 1:

Examiner respectfully disagrees with applicant's assertion that the items are not included within the security feature. Examiner cites column 4 lines 62-67 in the office action which states, "The combination of the personal information and a digital descriptor of the photograph and/or personal information forms a code, which after encrypting with a secret key, is recorded in area 3". Figure 1 clearly shows that the first set of information (item 1) is in an unencrypted form.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., equipment, fabrication operator, workstation, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claim 2:

Column 3 lines 59-60 disclose an issuer identification number that uniquely identifies the issuer of the card, therefore the issuer identifies from whom the card

comes from. Since the number is unique, it can be linked to a specific issuer or operator.

Regarding claim 13:

Applicant's use of document inventory number is a serial number as used by the applicant in the claims. Therefore, the unique identification number as used in Chow anticipates claim 13. Examiner erred in saying that it would have been obvious to move the identification number from section one to section two.

Regarding claim 15:

Examiner disclosed that the claim was interpreted to be "the ID is authentic via the ID's signature." Examiner further went on to disclose that it is common to sign a document with the manufacturer's/creator's key in order to identify that the article is from a trusted source. The manufacturer/creator is a fabrication detail as it discloses who created it.

Regarding claim 16:

Examiner relied upon the two-dimension symbology as a watermark for claim 16, as a watermark is not just used via steganography or data hiding, but can also be a visible, perceptible form of watermark also. In this case, the watermark (item 3 in figure 2) is visible and it identifies information such as the owner of the card.

Regarding claim 27:

Examiner cited claims 15-25 as being similar to claims 27 and 28. Claim 21 discloses the method of claim 18, which depends on 19, 18, and 15. Claim 21 teaches the fourth and fifth lines of claim 27, claim 20 teaches the third line, claim 18 teaches

the second line, and claim 15 teaches the first line of the claim. Therefore, the rejection of claim 21 incorporates the claimed subject matter of claim 27.

Regarding claim 29:

Examiner upholds the rejection of claim 29 as the serial number (being randomly or pseudo-randomly generated) will be recorded in a database along with who issued the card and when it was issued (fabrication details) among other numerous information about the identification document. This is common in the art to keep a record of cards that have been issued. Systems such as a Division of Motor Vehicles and U.S. Passport are examples of such a system.

Applicant's arguments, see page 8, filed 07/06/2007, with respect to claim 8 have been fully considered and are persuasive. The rejection of claim 8 has been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 21 was amended to add "but not expired" to describe the untrusted date. Examiner is unable to find any disclosure of an untrusted date being not expired in applicant's disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to one of ordinary skill in the art as to what is being defined by the "first stage" and "second stage" of a document fabrication process.

***Claim Rejections - 35 USC § 103***

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow et al. (US 6,292,092) in view of Chen et al. (US 5,694,471).

Regarding claims 1 and 5:

Chow et al. discloses an identification document comprising a photographic representation of a bearer of the identification document (figure 2, item 2) and indicia provided on the document (figure 2, item 1), the identification document further comprising a security feature printed on a surface of the identification document in a two-dimensional symbology (figure 2, item 3), the security feature including: a first set of information corresponding to at least one of the identification document, the bearer of the identification document (figure 2, item 1 shows the bearers information in plain text) and an issuer of the identification document (figure 2, examiner interprets the Canadian flag as an identification of the issuer), wherein the first set of information comprises an unencrypted form; and a cryptographic measure associated with the first set of information (column 4 lines 62-67). Chow et al does not disclose the cryptographic measure identifying at least a record of fabrication for the identification document. Chen

et al. discloses an issuer identification number (column 7 lines 37-48) that is used in a public/private key pair (column 8 lines 9-21). It would have been obvious to one of ordinary skill in the art at the time of invention to combine the identification document disclosed by Chow et al. with the record of fabrication used in the cryptographic measure in order identify who issued the document.

Regarding claim 2:

Chow et al. and Chen et al. disclose the identification document of claim 1, wherein the record of fabrication identifies at least one of equipment used in fabricating the identification document, an identification document assembler, a distribution channel and an operator of document fabrication equipment (Chen et al. discloses the issuer identification number. It is inherent that the issuer identification number discloses the operator of document equipment (either an individual or organization)).

Regarding claim 3:

Chow et al. discloses in figure 2, item 1 that the set of information comprises an identification number, name, birth date, and blood type (physical attribute).

Regarding claim 4:

Chow et al. discloses the two-dimensional symbology comprises a 2-D barcode (figure 2, column 3 lines 1-2).

Regarding claims 6 and 7:

Chow et al. and Chen et al. disclose the identification document of claim 1. The use of certificates with public/private key pairs is inherent in the art. Additionally, the certificate comprising a public key for decrypting is also inherent in the art.

Regarding claims 8 and 9:

Chow and Chen disclose the identification document of claim 6, but do not disclose wherein the cryptographic measure comprises an encrypted form corresponding to at least a first private key and a second private key. However, multiple key encryption is well known in the art and it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate multiple key pairs allowing for cascaded encryption that would further encrypt the information. Chen discloses the use of a private key associated with the issuer's identification number, but neither Chen nor Chow disclose an association of the private keys with the equipment used or corresponding to a stage of a document fabrication process. Associating keys with values is well known in the art and it would have been obvious to one of ordinary skill in the art at the time of invention to associate the keys with attributes.

Regarding claims 10 and 11:

Chow et al. discloses the cryptographic measure comprises a hash of at least the first set of information and a second set of information (item 1 and 2, column 3 lines 43-51). The hash is later encrypted by the private key (column 5 lines 1-6).

Regarding claim 12:

Chow et al. discloses the second set of information comprises a condensed representation of the photographic representation (column 5 lines 65-66).

Regarding claim 13:

Chow et al. discloses in figure 2, item 1 an identification number (an identification number is unique to the ID and therefor can be used as an inventory number, where it is

located). It would have been obvious to one of ordinary skill in the art to move the identification number from section 1 to section 2 using either an overlay or a displaying the ID number at a side of the picture.

Regarding claim 14:

Chow et al. discloses the indicia comprises at least text and a barcode (figure 2).

Regarding claims 15, 18, 19, and 26:

Chow et al. discloses a method of analyzing an identification document, the identification document comprising a first set of information and a cryptographic signature corresponding to the first set of information, wherein the first set of information and the cryptographic signature are encoded in a machine-readable format, the encoding being printed or engraved on a surface of the identification document, said method comprising: machine-sensing the first set of information and the cryptographic signature (column 5 lines 9-30); and determining fabrication details of the identification document from at least the cryptographic signature (examiner interprets this to mean if the ID is authentic via the ID's signature, column 5 lines 9-30; it is inherent that the document's signature is correct or the document will be considered fraudulent; the use of certificates is inherent in public/private key pair methods; It is common to sign a document with the creator's/manufacturer's signature in order to identify authenticity of the document and verify it is a trusted origin and it would have been obvious to one of ordinary skill in the art at the time of invention to sign with the creator's/manufacturer's signature).

Regarding claims 16 and 17:

Chow et al. discloses digital watermarking in the form of a two-dimensional symbology (figure 2, item 3).

Regarding claim 20:

Chow et al. discloses the method of claim 19, but does not disclose the method of determining whether the certificate has been revoked. It would have been obvious to one of ordinary skill in the art to check a trusted third party to find out the authenticity and status of the certificate.

Regarding claim 21:

Chow et al. inherently discloses the use of certificates through the use of public/private key pairs. It is inherent to check the date of the certificate in order to ensure that the certificate has not expired. If the certificate is not valid, then the signature is not valid.

Regarding claims 22 and 23:

Chow et al. discloses the method of claim 18 and the use of asymmetric keys (column 5 lines 1-6), but does not disclose the use of symmetric keys or the use of a trusted third party. It would have been obvious to one of ordinary skill in the art at the time of invention to check the authenticity and status of the certificate with a trusted third party, as it is common with certificates and public/private key pairs. Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention to use a symmetric key in order to make key computation and signatures computationally less intensive.

Regarding claims 24 and 25:

Chow et al. discloses the method of claim 18, but does not disclose the information that the certificates contain. It would have been obvious to include the information about manufacturing/creating the document in the document's certificate.

Regarding claims 27 and 28:

Claims 27 and 28 are similar to claims 15-25 and are therefore rejected under the same reasoning.

Regarding claims 29 and 32:

A method to establish whether an identification document should be trusted comprising: randomly or pseudo-randomly selecting a unique serial number; associating the unique serial number and fabrication details in a data record; providing the unique serial number on the identification document; and issuing the identification document (examiner interprets the following steps as a method of creating an identification document; Chow et al. discloses an identification document with a document number in figure 2, item 1; it is inherent to generate a serial number, assign a serial number to a item, record the item, serial number, and fabrication details (creation date/issue date/completion date, issuer, etc.) in a database, and to issue the item).

Regarding claims 30 and 31:

Chow et al. discloses the identification number as a form of text in section 1 of figure 2. Chow et al. further discloses using the information in section 1 as an input to generate the barcode (figure 2, section 3) in column 3 lines 43-51.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Turchen whose telephone number is 571-270-1378. The examiner can normally be reached on MTWRF 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571)272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRT



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PRIMARY EXAMINER